

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Venegas, Jr.

Serial No.: 09/829,033

Group No.: 2875

Filed: April 9, 2001

Examiner: Sawhney

For: LIGHTED STANCHION COVER

**APPELLANT'S CORRECTED AND REVISED
APPEAL BRIEF UNDER 37 CFR §41.37**

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed September 4, 2007, Appellant hereby submits its corrected Brief.

I. Real Party in Interest

The real party in interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 12 claims. Claim 12 has been allowed. Claims 1-12 are pending; however, claims 1-11 are rejected and under appeal. Claim 1 is sole rejected independent claim.

IV. Status of Amendments Filed Subsequent Final Rejection

No after-final amendments have been filed.

V. Summary of the Claimed Subject Matter

Independent claim 1 is directed to a lighting assembly for use with a stanchion (12) extending outwardly from a ground surface (16). The assembly includes an elongated tubular body (22) having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface. A lighting assembly includes a light source (14) interconnected to a power source (32, 32'), the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity. (Specification, page 5, line 12 to page 7, line 21).

VI. Grounds of Rejection to be Reviewed on Appeal

A. The rejection of claims 1-6 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,121,307 to Moore.

B. The rejection of claims 7-8 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,121,307 to Moore in view of U.S. Patent No. 3,855,924 to Morse.

C. The rejection of claims 9-11 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,121,307 to Moore in view of U.S. Patent No. 4,819,135 to Padilla et al.

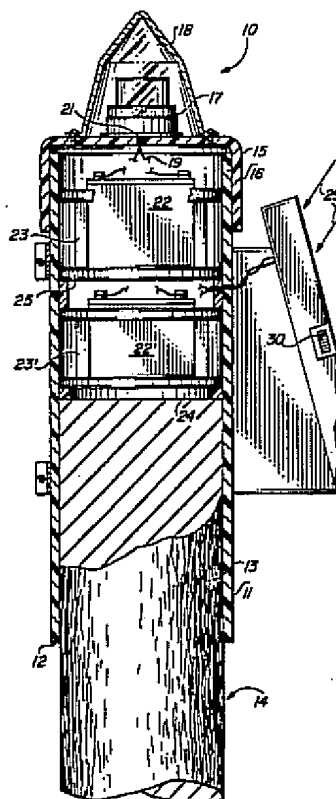
VII. Argument

A. The Rejection of Claims 1-6

Claims 1-6 stand rejected under 35 U.S.C. §103(a) over Moore, U.S. Patent No. 5,121,307. Claim 1 includes the limitation of a cover that receives a stanchion substantially in its entirety, such that the bottom (open) end of the cover is proximate to, or in contact with, a ground surface. This clearly distinguishes over the Moore reference.

The Moore patent is directed to a pole-mounted, self-contained, solar-powered strobe light

utilizing ultraviolet rays from the sun (and moon) for charging its batteries and employing a cylindrical housing open at one end for fitting over the top of a vertically mounted pole. Batteries are insertable in the other end of the housing which are covered by a cap for closing this end of the housing. The cap has mounted on it a strobe light connected to the batteries and covered by a transparent magnifying lens (U.S. Patent No. 5,121,307, Abstract).



The housing (shown above) is adapted only to fit over the top end an electric power or telephone pole (col. 2, lines 18-19). Clearly the cover of Moore could not extend down to a ground surface due to the wires and other obstacles that telephone and utility poles are designed to support. Given that obviousness cannot defeat a purpose for which a prior-art invention is intended, *prima facie* obviousness has not been established.

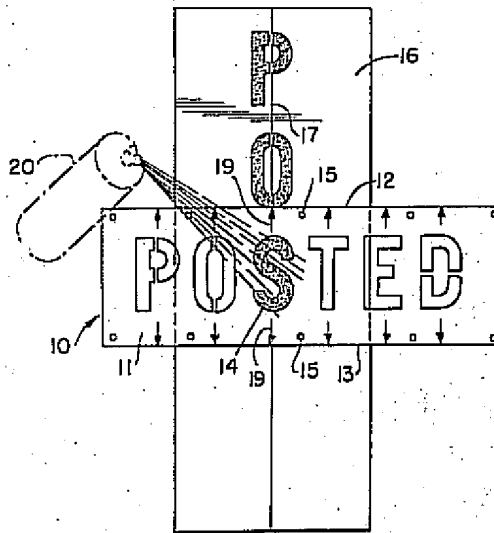
B. The Rejection of Claims 7 and 8

Claim 7 includes the limitation that the elongated tubular body of claim 1 displays a message. This claim stands rejected under 35 U.S.C. § 103(a) over Moore in view of U.S. Patent No. 3,855,924 to

Morse. The Examiner concedes that Moore does not teach an elongated tubular body displaying a message, but proposes the Moore/Morse combination “to display messages [sic] in a simple and cost saving manner. The Examiner’s argument is not persuasive on several grounds. First, there is no teaching or suggestion from the prior art to combine these references. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Appellant’s claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner has not met this mandate.

Second, Morse is non-analogous art. “In order to rely on a reference as a basis for rejection of an Appellant’s invention, the reference must either be in the field of Appellant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem”); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Morse resides in a sign making stencil method. “The principle object of the invention is to provide a very simple and easily manipulable stencil which may be used selectively in one position to make an entire sign in one direction, or may be shifted indicia-by-indicia to make a sign at right angles to the first mentioned direction.” (Morse, Jr., col. 1, lines 14-19)



Thus, Morse is concerned with sign-making in general and orthogonal lettering in particular (see above). Appellant's problem to be solved is that of *lighted stanchions*. But for the Examiner's unfounded arguments, the subject matter of the two inventions do no overlap.

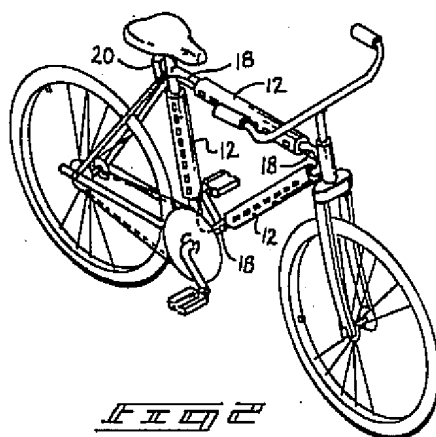
C. The Rejection of Claims 9-11

Claims 9 stand rejected under 35 U.S.C. §103(a) over Moore in view of Padilla et al., U.S. Patent No. 4,819,135. The Examiner concedes that Moore does not disclose light-dispersing windows, a message displayed by a plurality of light sources, or light sources in the form of light-emitting diodes. The Examiner states that it would have been obvious to modify the lighting assembly of Moore with the tubular body taught by Padilla "for benefits and advantages of eye-catching displays and for traffic safety in dark." However, Appellant disagrees for several reasons. First, as discussed above, given that the cover of Moore is intended for tops of utility poles, and the like, at distances high above the ground, the desirability of an "eye-catching display" makes little practical sense. In addition, it is well settled that in order to establish *prima facie* obviousness in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Furthermore, as with Morse, Padilla represents non-analogous art. "In order to rely on a reference as a basis for rejection of an Appellant's invention, the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem"); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In this case, Padilla, being directed to a bicycle lighting device (see #12, below) bears no relation whatsoever to the problem facing Moore, or Appellant.



Conclusion

This application was originally filed in April 2001. This is the second appeal; the Examiner withdrew the first on largely similar points of argument. For all of the arguments of record, all pending claims of the subject application continue to be in condition for allowance, and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

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APPENDIX A**CLAIMS ON APPEAL**

1. A lighting assembly for use with a stanchion extending outwardly from a ground surface comprising:

an elongated tubular body having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface; and

a lighting assembly, having a light source interconnected to a power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity.

2. The lighting assembly of claim 1 wherein the power source is external to the lighted stanchion cover.

3. The lighting assembly of claim 2 further includes an electronic circuit for power management and control.

4. The lighting assembly of claim 3 further including a light source receptacle for receiving a lamp.

5. The lighting assembly of claim 1 wherein the power source is a plurality of photovoltaic devices that are supported by the elongated tubular body.

6. The lighting assembly of claim 1 wherein the power source is a battery.

7. The elongated tubular body defined in claim 1 wherein the body displays a message.

8. The elongated tubular body defined in claim 1 wherein the message is stenciled letters or

an image upon the body.

9. The elongated tubular body defined in claim 1 wherein the body includes one or more light dispersing windows.

10. The elongated tubular body of claim 7 wherein the message is displayed by a plurality of light sources supported by the thickness of the body.

11. The elongated tubular body of claim 10 wherein the plurality of light sources are light emitting diodes.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.